

REMARKS

The Applicant has received and has carefully studied the Office Action mailed March 24, 2004. Upon entry of the amendment as proposed above, the application will contain one fewer claim, i.e. the claims in the application will be claims 1-5, 9 and 11-14. These claims define patentable subject matter warranting their allowance. Accordingly, the applicant respectfully requests favorable reconsideration, entry of the amendments submitted above and allowance.

Undersigned has reviewed all the Office Actions issued by the PTO in the above-identified application, and does not see that the PTO has acknowledged receipt of applicant's papers filed under §119. Applicant has claimed priority and applicant has filed a certified copy of the French priority application. **Accordingly, applicant respectfully requests the PTO to acknowledge receipt of applicant's papers filed under §119.**

Claims 1-5 and 9-14 have been again rejected as obvious under §103 from Griffith in view of applicant's acknowledgment that silicone materials are known. The same claims have also been rejected as obvious under §103 from

Griffith in view of either Richno or Mellea¹. These rejections are respectfully traversed.

Both rejections proceed on the basis that applicant's invention is only the substitution of a polysiloxane (or silicone elastomer) for the typical "Bungee" cord, but this is not correct. To bring out the differences more clearly, applicant's proposed amendment above incorporates a feature previously called for in claims 5 and 14, i.e. a minimum thickness of 6 mm, and incorporates this feature into claims 1 and 11. In conjunction therewith, applicant proposes to further amend the main claims to make clear that the claimed elastic tensioning cable is composed "entirely" of the polysiloxane, support being found for example at page 3, line 36.

A sample of applicant's elastic tensioning cable is attached hereto, as is a sample of a typical prior art tensioning cable, e.g. a "Bungee" cord, the latter being

¹ In the last Reply, applicant pointed out that Mellea has a filing date which is after applicant's priority date. In reply, the examiner indicated at the top of page 3 of the Final Action that he is relying on Mellea's provisional application 60/192,902. However, according to PTO regulations, if an examiner is relying on a provisional application, the PTO must provide applicant with a copy of the provisional application so that the applicant can see if there is support in the provisional application for what appears in the publication of the subsequent non-provisional application. The PTO has not provided applicant with a copy of Mellea's provisional application, and therefore applicant does not know whether or not Mellea's provisional application provides support for that which is relied upon in the Mellea publication. If the examiner intends to continue to rely on Mellea, Applicant requests that the PTO forward a copy of Mellea's provisional application.

modified according to the proposed combination rejection, i.e. substituting the rubber strands with silicone strands.

The typical prior art tensioning cable comprises a plurality of small diameter strands encased in an outer wrapping, consistent with what is shown in the attached sample (modified prior art) and as stated under the heading "Prior Art" in applicant's specification at pages 1-3. Thus, the following text, which is accurate, appears at page 1 of applicant's specification, commencing at line 30:

Elastic tensioning cables of known type generally consist of a core based on rubber yarns and of a textile sheath, generally formed from braided yarns. More specifically, the rubber yarns are generally based on a natural latex and are combined in a bundle in order to form the necessary diameter.

As regards the covering or sheath, applicant's specification further states as follows, noting the paragraph spanning pages 1 and 2 of applicant's specification:

This bundle of natural latex yarns is protected by a braided sheath, generally made of polypropylene, polyethylene, polyamide, polyester or cotton. This sheath protects the latex yarns from mechanical damage that might arise when the cable is subjected to high mechanical stresses.

The prior art teaches nothing different from what is outlined in applicant's specification, such as quoted above, except (according to Richno, and possibly according to Mellea) that

instead of being formed of natural latex, the rubber yarns or strands could be formed of silicone elastomer.

Simply substituting a silicone elastomer for natural rubber does not reach applicant's invention. For example, applicant's elastic tensioning cable is in the form of a rod, i.e. it has a large diameter or thickness and is a single strand.

In this regard, applicant's specification states at page 4, lines 11-14, as follows:

The elastic tensioning cable according to the invention is therefore in the form of a rod free of any external protective layer.

Thus, even if the combination as proposed were obvious, the result would not correspond to the claimed subject matter. This is clear from the attached exhibit of samples.

Applicant has pointed out previously that the present invention provides a number of advantages, and applicant's comments in those regards are respectfully repeated by reference. In particular, applicant wishes to emphasize the relatively high cost of the prior art tensioning cables, e.g. "Bungee" cords, which require the assembly of a plurality of strands and then the covering of those strands with a sheath such as a double braided sheath as mentioned in applicant's specification. Another related problem with the prior art tensioning cables is mentioned in applicant's

specification at page 3, commencing with line 11, relates to the special problems of butt-joining various sections. As pointed out above, and in contrast to the prior art, applicant's elastic tensioning cable is "in the form of a rod free of any external protective layer."

Withdrawal of the rejections is in order and is respectfully requested.

As regards dependent claims 2 and 11, the Final Rejection explicitly states that the recitations of the dependent portions of these claims "is not given weight due to the fact that the present claims are article claims." Respectfully, this is unjustified and improper. First, there is a general rule that any recitation which serves to define the invention is to be given weight, and there is another general rule that any applicant is to be given wide discretion in how he or she claims his or her invention (see, for example, the words of the Supreme Court of the United States in *Brown v. Guild*, 90 US 181, 224; also see *In re Miller*, 169 USPQ 597; *In re Moore*, 169 USPQ 236, 238; *In re Swinehart*, 169 USPQ 226, 228; *In re Echerd et al*, 176 USPQ 321; *In re Wilson*, 165 USPQ 494, 496).

These cases are significant and appropriately cited because the recitations of claims 2 and 11 serve to define the

nature of the product. In other words, the fact that the cable is obtained by extrusion serves to further characterize the product, because extrusion gives the product certain inherent properties which would not be present if it were formed in a different way. Attention is respectfully invited to *In re Luck et al*, 177 USPQ 523, 525 (CCPA 1973), where the Court stated as follows:

As for the method..., it is well established that product claims may include process steps to wholly or partially define the claimed product. [citation omitted] To the extent these process limitations distinguish the **product** over the prior art, they must be given the same consideration as traditional product characteristics. (emphasis in original)

Nevertheless, to better emphasize that the "extrusion" recitation of claims 2 and 11 is a definition of what the product is rather than how it is made, applicant proposes above to amend these claims to define that the product is in the form of a extrudate.

The Final Action also states that the "color, cross section and diameter are limitations which would have been obvious design modifications." Applicant respectfully strongly traverses the PTO's position in this regard, particularly as regards the diameter (or thickness). Insofar as is known, and it is certainly not shown by the prior art applied, the prior art has not previously proposed a rod-like

elastic tensioning cable, i.e. a cable having a minimum thickness of 6 mm. This is an important aspect of the present invention, as it results in a single rod-like strand of simplified construction, without the need for a covering sheath, and without the need to assemble a plurality of yarns to form a core as in the prior art.

Thus, the brushing aside of important claimed features is, applicant respectfully submits, contrary to well accepted law and practice. The law requires the PTO to provide evidence of obviousness, but there is no evidence of obviousness as regards features which the PTO says only "would have been obvious design modifications", especially thickness or diameter. It is improper for the PTO to merely brush aside a recitation as requiring "obvious design modifications" without any evidence of obviousness.

Applicant respectfully notes and relies upon *Ex parte Levengood*, 28 USPQ2d 1300, 1301 (BPAI 1993), where the Board emphasized the necessity for evidence:

In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present **evidence**, [footnote and citations omitted] preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge... [citations omitted; italics in original]

There are many prior decisions which emphasize that no recitation in an applicant's claims should be ignored. Please

note *In re Glass*, 176 USPQ 489, 491 (CCPA 1973), where the court stated:

It is error to ignore specific limitations distinguishing over the references.

Please also see *In re Echerd et al*, *supra* at 176 USPQ 322 (CCPA 1973), where the court indicated that "potentially distinguishing features cannot simply be ignored."

Applicant understands the expression "obvious design modifications" by one reasonably skilled in the art to mean that what the applicant did is, in the Examiner's view, a mere matter of choice which could be done by any person skilled in the art (if they wanted to do so). But see *Ex parte Haas et al*, 144 USPQ 98,99:

Why the Examiner states that the particular features of novelty, which give results that the reference device cannot give, are arbitrary, we cannot understand. Changes yielding new and improved results are never arbitrary. They are made for the purpose of yielding the new and improved results.

The Examiner then says that these are a matter of choice. It is not a matter of choice presented by the prior art [which] gives only one choice; a process which will not yield these new and improved results.

Also see *Ex parte Deere*, 118 USPQ 541,544; and *Ex parte Krantz*, 61 USPQ 238.

In an unpublished decision (September 30, 1986) in Appeal 5800-81, the Board, in reversing a rejection in a case

where the Examiner had brushed aside a recitation appearing in the claim under appeal, concluded as follows:

The examiner's assertion at page 4 of the Answer that the proposed modification would have been "an obvious matter of engineering design choice well within the level of one of ordinary skill in the art" is a conclusion, rather than a reason.

Applicant respectfully submits that it is contrary to fact in the present case that providing applicant's minimal thickness of the claimed tensioning cable would require nothing more than routine experimentation; it is also contrary to the well established case law, including that cited above, which requires the prior art to show that alternatives are equivalent (see *In re Scott*, 139 USPQ 297; and *In re Flint*, 141 USPQ 299) before the PTO can validly hold that doing one in place of the other would simply be obvious. There is no such prior art in the present case.

Lastly, for a more recent decision on this point, attention is respectfully invited to *In re Chu*, 26 USPQ2d 1089, 1095 (Fed Cir 1995).

The prior art does not establish a *prima facie* case of obviousness, i.e. applicant's claims define novel and unobvious subject matter over the prior art. Accordingly, applicant respectfully requests withdrawal of the prior art rejections.


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Favorable reconsideration, entry of the amendments
presented above and allowance are all earnestly solicited.

Respectfully submitted,

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